

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of Applicant)
 Hirohisa KIKUYAMA et al.) Art Group:
 Serial No.: 09/622,397)
 Filing Date: August 16, 2000)
 Title: SURFACE TREATING FOR) Examiner:
 MICROMACHINING AND)
 METHOD FOR SURFACE)
 TREATMENT)

Hon. Commissioner for Patents
 Box: Missing Parts
 Washington, D.C. 20231



RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS
AND DEFECTIVE OATH
RESPONSE TO NOTICE OF DEFECTIVE TRANSLATION

Dear Sir:

Responsive to the Notification of Missing Requirements and Defective Oath and Notice of Defective Translation dated October 27, 2000, Applicant hereby submits the following remarks:

REMARKS

Enclosed herewith please find an executed declaration for the above-identified application, along with the surcharge for providing the declaration later than the appropriate 20 or 30 months from the priority date of One Hundred Thirty Dollars (\$130).

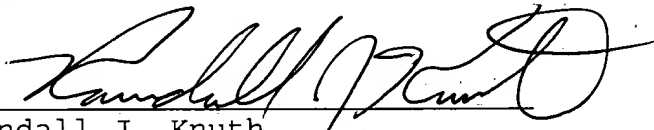
Also enclosed please find a corrected English translation of the claims accompanied by a verification of the translation.

Additionally, Applicant respectfully submits that the Examiner did not indicate receipt of the Preliminary Amendment submitted with the filing of the application on August 16, 2000. Applicant has enclosed a copy of said Preliminary Amendment along with a copy of the return postcard date stamped by the USPTO on August 16, 2000, which verifies receipt of the Preliminary Amendment.

Further, Applicant respectfully submits that all of the requirement have now been met for issuance of a Filing Receipt.

If the Examiner has any questions regarding the foregoing, Applicant invites the Examiner to contact the undersigned at 219-485-6001.

Respectfully submitted,


Randall J. Knuth
Registration No. 34,644

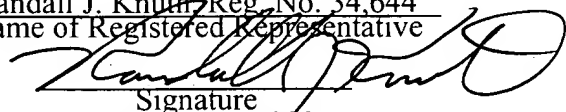
RJK/jrw

Encs: Executed Declaration
Check No. 4789 (\$130)
Corrected English Translation
of the Claims
Verification of Translation
Copy of Preliminary Amendment
previously submitted
Copy of Return Postcard date
stamped by the PTO on 8/21/00
Form PCT/DO/EO/905 (Copy)
Form PCT/DO/EO/917 (Copy)
Form PCT/DO/EO/913 (Copy)
Return Postcard

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner of Patents and Trademarks,
Washington, DC 20231, on November 27, 2000.

Randall J. Knuth, Reg. No. 34,644
Name of Registered Representative


Signature
November 27, 2000
Date

COPY

09/622397



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: ASSISTANT COMMISSIONER FOR PATENTS
Box PCT
Washington, D.C. 20231

U.S. APPLICATION NO. 09/622,397	FIRST NAMED APPLICANT KIKUYAMA	ATTY. DOCKET NO. 4
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022855
RANDALL J KNUTH P.C.
3510 A STELLHORN ROAD
FORT WAYNE IN 46815-4631

INTERNATIONAL APPLICATION NO. 5611 PCT/JP99/00936	
I.A. FILING DATE 02/26/99	PRIORITY DATE 02/27/98
DATE MAILED: 10/27/00	

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as:

- ☐ a Designated Office (37 CFR 1.494),
- ☒ an Elected Office (37 CFR 1.495):
- ☒ U.S. Basic National Fee.
- ☒ Copy of the international application in:
 - ☐ a non-English language.
 - ☐ English.
- ☐ Translation of the international application into English.
- ☐ Oath or Declaration of inventor(s) for DO/EO/US.
- ☐ Copy of Article 19 amendments.
- ☐ Translation of Article 19 amendments into English.
- ☐ The International Preliminary Examination Report in English and its Annexes, if any.
- ☐ Translation of Annexes to the International Preliminary Examination Report into English.
- ☐ Preliminary amendment(s) filed _____ and _____
- ☒ Information Disclosure Statement(s) filed 16 Aug 00 and _____
- ☐ Assignment document.
- ☐ Power of Attorney and/or Change of Address.
- ☒ Substitute specification filed 16 Aug 00
- ☐ Statement Claiming Small Entity Status.
- ☐ Priority Document.
- ☒ Copy of the International Search Report ☐ and copies of the references cited therein.
- ☐ Other:

REC'D NOV 02 2000

2. The following items MUST be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☒ a. Translation of the application into English. Note a processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
 - ☒ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
- ☒ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
- ☐ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the international application number and international filing date.
 - ☒ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
- ☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

3. Additional claim fees of \$ _____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.

ALL OF THE ITEMS SET FORTH IN 2(a)-2(d) AND 3 ABOVE MUST BE SUBMITTED WITHIN ONE MONTH FROM THE DATE OF THIS NOTICE OR BY ☐ 21 OR ☒ 31 MONTHS FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

- 4. Translation of the Annexes MUST be submitted no later than the time period set above or the annexes will be cancelled. Note processing fee will be required if submitted later than 30 months from the priority date.
- 5. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

Enclosed: ☒ PCT/DO/EO/917
☐ PTO-875

☒ Notice of Defective Translation

FORM PCT/DO/EO/905 (December 1997)

Telephone: (703) 3053737

01/622397



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT COMMISSIONER FOR PATENTS
Washington, D.C. 20231

U.S. APPLICATION NO. 097522-397	KIKUYAMA	FIRST NAMED APPLICANT H	ATTY. DOCKET NO. FUK-75
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022855
RANDALL J KNUTH P.C.
3510 A STELLHORN ROAD
FORT WAYNE IN 46815-4631

INTERNATIONAL APPLICATION NO. PCT/JP99/00936

I.A. FILING DATE 02/26/99	PRIORITY DATE 02/27/98 10/27/00
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DATE MAILED:

COPY

NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION

This application fails to contain an oath or declaration acceptable under 35 U.S.C. 371 (c)(4) for entry into the national stage in the United States of America. The period within which to correct these requirements and avoid abandonment is set in the accompanying Office action.

A new oath or declaration, identifying this application by the international application number and international filing date is required. The oath or declaration does not comply with 37 CFR 1.497(a) and (b) in that it:

1. ☒ is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68.
2. ☐ does not identify the specification to which it is directed.
3. ☐ does not identify the inventor(s).
4. ☐ does not identify the citizenship of each inventor.
5. ☐ does not state the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

FAILURE TO SUBMIT AN OATH OR DECLARATION IN COMPLIANCE WITH 37 CFR 1.497(a) AND (b) WITHIN THE TIME PERIOD SET WILL RESULT IN FAILURE TO ENTER THE NATIONAL STAGE AND THE ABANDONMENT OF THE APPLICATION.

Additionally, the oath or declaration does not comply with 37 CFR 1.63 in that it:

1. ☐ does not identify the city and state or city and foreign country of residence or each inventor.
2. ☐ does not state that the person making the oath or declaration:
 - a. ☐ has reviewed and understands the contents of the specification, including the claims, as amended by any amendment specifically referred to in the oath or declaration.
 - b. ☐ acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56.
3. ☐ does not identify the foreign application for patent or inventor's certificate on which priority is claimed pursuant to 37 CFR 1.55, and any foreign application having a filing date before that of the application on which priority is claimed, by specifying the application serial number, country, day, month, and year of its filing.
4. ☐ does not state that the person making the oath or declaration acknowledges the duty to disclose information which is material to patentability as defined in 37 CFR 1.56 which became available between the filing date of the prior application and filing date of the continuation in part application which discloses and claims subject matter in addition to that disclosed in the prior application (37 CFR 1.63(d)).

Marc Person
Telephone: (703) 3053737

COPY



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: ASSISTANT COMMISSIONER FOR PATENTS
Box PCT
Washington, D.C. 20231

09/622397
U.S. APPLICATION NO.

09/622397

ATTACHMENT TO FORM PCT/DO/EO

NOTICE OF DEFECTIVE TRANSLATION

The received translation is defective because:

- ☐ (1) The text in the drawings has not been properly translated;
- ☒ (2) The number of claims in the International Application and the number of claims in the translation are not the same: *Claim 7 is missing.*
- ☐ (3) The translation of the International Application is incomplete as a number of pages are missing;
- ☐ (4) Other.

Mamie Teran
Telephone: *703 305 3737*



VERIFICATION OF CORRECTED TRANSLATION OF CLAIMS

I, the below named translator, hereby declare that:

My name and post office address are as stated below;

That I am knowledgeable in the English language and in the language in which the international application PCT/JP99/00936 was filed; and that the attached corrected English translation of the claims for the international application PCT/JP99/00936 is a true and complete translation.

I further declare that the correction is necessary due to an erroneous typo which was originally filed in the national stage filing of international application PCT/JP99/00936 on August 16, 2000 in the United States Patent and Trademark Office under Application Serial No. 09/622,397.

I hereby declare that all statements made herein of my knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize validity of the application or any patent issued thereon.

Full name of the translator:

Satoshi HOSHIKOSHI

Signature of the translator:

Satoshi Hoshihoshi

Date:

November 27, 2000

Post Office Address:

2nd floor, Fuji Building

5-11, Kudanminami 4-chome

Chiyoda-ku, Tokyo 102-0074

JAPAN